REMARKS

In the first Office Action, the Examiner requested a substitute specification, rejected claims 1 – 21 under the second paragraph of section 112, rejected claims 1, 2 and 5 as anticipated by the Luther et al. reference, rejected claims 3 and 6 – 9 as obvious over the Luther et al. reference in view of the Tanaka reference, and rejected claims 4 and 15 - 21 as obvious over Luther in view of Casey at al.

Substitute Specification

A substitute specification as requested by the Examiner has been prepared and is attached hereto. In addition to the changes of the Preliminary Amendment, the two part Figures 3a and 3b and 4a and 4b have been correctly identified in the detailed description.

35 U.S.C. §112, 2nd ¶

The phrase objected to by the Examiner in **claim 1** is found in the portion deleted from the claim by the Preliminary Amendment. The rejection is therefore in error.

Claim 15 has been amended to cure the antecedent basis problem, and **claim 21** has been amended to depend from claim 7 for a proper antecedent basis for the claimed phrase.

Applicant notes the rejection of the dependent claims for dependence on rejected base claims and further notes that such a rejection is usually reserved for claims that are otherwise allowable.

35 U.S.C. §102(e)

In **Luther et al.**, completed, or filled in, printed forms are scanned and the scanned image is compared to blank form profiles in a form dictionary until the completed form is identified as fitting one of the form profiles. The scan of the completed form is then compared

to the identified form profile and any dissimilar image data is extracted as the data that has been filled in on the form. The extracted data is stored for display to an operator. The form profiles are developed by scanning of blank forms and storing the scanned image data.

The present invention provides that form data is distinguished from variable while the data is in a printer data format, as provided in claim 1 as now presented. The cited Luther reference does not disclose that the data is in a printer data format, as acknowledged by the Examiner in section 9 of the action, and so the invention is not anticipated by Luther.

35 U.S.C. §103(a)

The **Casey et al.** reference does not perform printer specific data formatting, but instead distinguishes the form data from variable data only while it is scanned data. In other words, Casey performs the extraction from scan data, much like Luther does.

The passage cited by the Examiner in Column 4 does not teach or suggest the claimed invention. The scanned data of Casey is processed for optical character recognition to generate character data. The character data may be transmitted to peripheral devices such as a display, data storage or a printer. Nowhere does this suggest that form data is distinguished from variable data while in a printer data format. The present invention is thus non-obvious even when considered with the combination of Luther and Casey.

The Examiner is directed to the International Preliminary Examination Report for the present PCT application, wherein the present invention is contrasted with the Casey reference and found to meet the standards of patentability thereover. A copy of the English translation of the International Preliminary Examination Report is enclosed for the Examiner's review

The **Tanaka** reference fails to disclose the provide sufficient teaching to make the claims non-obvious, as it does not distinguish the data in the printer data format.

Schanding is argued by the Examiner but not formally cited. Assuming that the Schanding reference were viewed in combination with Luther and Casey, there is still insufficient teaching to make the invention obvious thereover. In particular, Schanding reduces direct memory access for ink jet control in a printer. Schanding reduces the amount of space required in the printer buffer memory during printing operations by use of memory access pointers that are accessed when the print data has a long string of zeros, representing a large white space that has no printing. Schanding seeks out white space in the print data and reduces the number of zeros required to represent this white space. Repetitive data blocks are treated the same way.

Accordingly, the invention as defined in the claims is non-obvious over the cited art, whether considered alone or in combination. Withdrawal of the rejections and early allowance of the application is thus in order.

Conclusion

The present invention as claimed is thus not shown or suggested in the prior art, and therefore is a non-obvious improvement thereover. Each issue raised in the action has been addressed. Early favorable reconsideration and allowance is hereby requested.

Respectfully submitted,

Melvin A. Robinson (Reg. No. 31,870)
Schiff Hardin & Waite
Patent Department
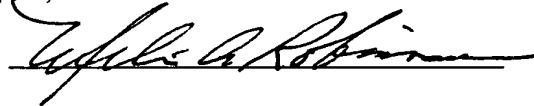6600 Sears Tower
Chicago, Illinois 60606
Telephone: 312-258-5785
ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

The Assistant Commissioner for Patents
Washington, D.C. 20231

on January 3, 2003.

VERSION MARKED TO SHOW CHANGES

The claims have been amended as follows:

1. (Twice Amended) A method for electronic archiving of a data stream output by a computer in a computer-specific data format that contains at least one of graphic information and text information, comprising the steps of:

distinguishing form data from variable data in the data stream based on pixels while said data

is in a printer data format; and

differently processing the two data types.

4. (Twice Amended) A method according to claim 20, wherein said printer data format is [step of distinguishing between form data and variable data ensues in the] printer-specific data [format].

15. (Twice Amended) An apparatus for electronic archiving of a [the] data stream output by a computer in a printer-specific data format that contains at least one of graphic and text information, wherein the print data stream is converted from the printer-specific data format into a data format based on pixels, comprising:

an archiving interface that differently processes form data in the data format based on pixels and variable data while said data is in the printer-specific data format.

21.(Amended) A method as claimed in claim 7 [1], wherein said overlay information is selected from the information consisting of control information, macro information, graphic information, predetermined text modules and predetermined text attributes.